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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/510,016

02/23/2005

George Telfer

257.038

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26722

7590

05/30/2008

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EXAMINER

NEUDER, WILLIAM P

ART UNIT

PAPER NUMBER

3672

NOTIFICATION DATE

DELIVERY MODE

05/30/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/510,016	<b>Applicant(s)</b> TELFER, GEORGE	
	<b>Examiner</b> William P. Neuder	<b>Art Unit</b> 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 5-9 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 5-9 have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 10, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis et al 6276452.

With respect to claim 1, Davis et al. disclose a downhole tool for collecting and retrieving junk from a well bore, the tool comprising: a cylindrical body (22,28) attachable in a work string (via 10); a multi-faceted surface (22) comprising a plurality of projections (23) arranged at an end of the body for contacting with and breaking up junk; and a plurality of inlet ports (26) through which the broken up junk passes into a trap (56) for collection, wherein each projection is located between adjacent inlet ports (see figure 2) and wherein adjacent projections (23) define channels there between which are shaped to direct the junk into the respective outlets (wherein the junk cannot go through the projections, so it has to go between them in order to go into the outlet). The tool body has an internal throughbore and a sleeve 18 located around the body defining a trap for junk.

With respect to claim 3, Davis et al. disclose that the tool further includes a sleeve (32) located around the body, the sleeve including filter means for filtering debris from fluid passing there through.

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With respect to claim 4, Davis et al. disclose that a trap is provided in an annular space between the body and the sleeve (see figures 1 and 2).

With respect to claim 10, Davis et al. disclose a method of collecting and retrieving junk within a well bore, comprising the steps: a) providing a multi-faceted contact surface (22) on a work string, the surface including a plurality of projections (23) and a plurality of inlet ports (26), each projection being located between adjacent inlet ports (see figure 2); b) breaking up large pieces of junk by contact with the surface (see column 4 lines 35-51); c) directing the broken up junk towards the inlet ports along channels defined between adjacent projections (wherein the junk cannot go through the projections, so it has to go between them in order to go into the outlet) and collecting the broken-up junk through the inlet ports; and d) storing the broken-up junk in a trap (56) adjacent the inlet ports.

With respect to claim 11, Davis et al. disclose that the method includes the steps of providing a mill (23) ahead of the surface and jetting milled junk from the mill towards the inlet ports (see column 5 lines 48-57).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al in view of Bjornstad 5682950.

With respect to claim 2, Davis et al is silent as to what material the projections are made from. Bjornstad discloses that the outer surface of the mill is covered by tungsten carbide because it is a material resistant to wear. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Davis et al. by making the projections from tungsten carbide as taught by Bjornstad because tungsten carbide is resistant to wear.

With respect to claim 6, Davis et al. does not teach a valve. Bjornstad teaches that it is known to use a valve in order to close the chamber (see column 1 lines 17-26). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Davis et al. to include a valve as taught by Bjornstad in order to keep the junk in the junk chamber, i.e. prevent it from exiting.

### ***Response to Arguments***

Applicant's arguments filed 3/27/08 have been fully considered but they are not persuasive. Applicant argues that the current amendments define a tool that uses forward circulation. Or rather, that the current amendments define over a device that uses reverse circulation. The amendments now define that the body has a throughbore and a sleeve located around the body. Clearly the entire string of Davis has a throughbore. All strings, either forward or reverse circulation have throughbores. By reading members 28 and 22 as the body, member 18 forms a sleeve around the body. Applicant is not seen to have defined over Davis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Neuder whose telephone number is 571-272-7032. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William P Neuder/  
Primary Examiner  
Art Unit 3672

W.P.N.